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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,549	09/04/2003	David W. Roth	B2745.0028/P0028	1609

7590  
BEH Investments  
1652 48th Street  
Brooklyn, NY 11204

EXAMINER
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DAGNEW, SABA

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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07/29/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,549	<b>Applicant(s)</b> ROTH ET AL.	
	<b>Examiner</b> SABA DAGNEW	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 99-166 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 99-166 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Reissue Applications***

1. This Office Action is in response to the amendment filed on 7 April 2011. The amendment replaced previously submitted Claims 99-166 with new Claims 99-166. Therefore, the currently pending claims considered below are Claims 1-17 and 99-166.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 April 2011 has been entered.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

“all oaths/declaration in a broadening reissue application must be signed by all of the inventors (except as otherwise provided in the rules – see 37 CFR §§ 1.42, 1.43, 1.47) In a non-broadening reissue application, either all the inventors or all the assignees must sign the oath or declaration” (MPEP 1410.01).

The instant reissue application contains broadening claims, and, thus, requires the signatures of all of the inventors.

4. Claims 99-166 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 15, and 99-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210)

7. Claims 1, 4, 15, and 99-166 are rejected under 35 U.S.C. 102(e) as being anticipated by Claims 1-7, 9, 12-14, and 17: Goldhaber discloses a system for supplying advertisements, comprising:

a. a web server storing a plurality of advertisements (*Col. 9, lines 62-67, which teaches Servers 106, store information (advertisement))*);

b. a plurality of bidding agents ( *Col. 4, lines 58-62, where "bidding agents" reads on plurality of bidding agents* );

c. a server for providing information concerning each view-op to the bidding agents *(Col. 2, lines 14-21, teaches advertising agency plan different approaches based on demographic lines 36-49, which teaches determining the advertising spot based on demographic information and characteristics of the show for inserting ads )*;

d. a bid input system for providing bids including a reference to a specific advertisement, specifications (parameters) for a desired view-op, and a monetary amount to be paid for displaying the specific advertisement *(Col. 5, lines 47-63, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (specification) and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction).*

Goldhaber teaches all elements as above including compete by bidding based on viewer's electronic selection of advertisements *(Col. 5, lines 47-63, and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction)* and inserting advertisement during popular television show *(Col. 2, lines 36-49)* and World Wide Web allows anyone to maintain public "home pages" that are visible to all *(Col. 8, lines 50-55)*. However, Goldhaber does not explicitly teach the server selecting the highest bid and transferring the advertisement to the web site. However, it would have been obvious to the one ordinary skills in the art at the time of the invention was made to including a feature that selects the highest bidder and transmit advertisement to a web site in order to increase advertising revenue.

Additionally, Goldhaber discloses a similar system for storing a viewer database with demographic and/or historic information pertaining to the viewer (content requestor) that is used by the advertiser to determine the bid amount *(Col. 6, lines 24-31, teaches a data base of*

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*digitally stored electronic demographic profile of potential viewers and Col. 4, lines 47-63, bids might be based, in part, on estimates of the viewer's interest and likelihood to buy – estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior ).*

Claim 8: Goldhaber disclose a system as in Claim 7 above, furthermore, Goldhaber teaches web is accessed using HTTP protocol (**Col. 16, lines 60-64**, which teaches URL address, which specified by the activated CyberCoin)

Claim 10: Goldhaber disclose a system as in Claim 9 above, furthermore, Goldhaber discloses checking the bids to determine if the web page meets (matches) the specification of the bid (**Col. 2, lines 36-49**, which teaches determining the advertising spot based on demographic information and characteristics of the show for inserting ads and **Col. 20, lines 36-55**).

Claim 11: Goldhaber disclose a system as in Claim 9, furthermore, Goldhaber discloses determination of which advertisement to place on a particular web page in done in machine real time and said bids are entered in human real time (**Col. 8, lines 22-39**, which teaches on-line trading (real time) where buyers and sellers (software agents) can actively fined each other an negotiating transaction, read on bids are entered).

Claim 15: Goldhaber discloses a system as in Claim 1 above, and further discloses the server includes information (database) about web sites (**Col. 6, lines 24-31**, teaches database that

*contains information files and Col. 15, lines 17-31, which teaches brokerage server contain (e.g. opera, winter sport, etc... ).*

Claim 16: Goldhaber discloses a method for supplying and pricing advertisements, comprising:

a. receiving electronic bids from advertisers for specific advertisements to be presented to clients with matching search terms (*Col. 4, lines 54-55, where "bids might be based in part of viewer interest" reads on matching search terms*);

b. transmitting the selected advertisement to the matching clients (*Col. 10, lines 9-15 customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers*);

c. calculating the delivery fee (bid cost) for the advertisement (*Col. 4, lines 32-40, where "determining direct payment is cost effective" calculating the delivery fee*); and

d. generating and transmitting an advertising bill to the advertiser (*Col. 1, lines 57-61, which teaches media receive its revenue from advertiser reads on transmitting advertizing bill to advertiser*).

e. storing client profile information in a database and using the profile information to determine the bid amount (*Col. 6 lines 34-30 teaches database that contain electronic profiles detailing preferences and past consuming behavior*).

Goldhaber teaches all elements as cited above including compete by bidding based on viewer's electronic selection of advertisements (*Col. 5, lines 47-63, and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction*) and inserting advertisement during poplar television show (*Col. 2, lines 36-49*) and World Wide Web allows

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anyone to maintain public "home pages" that are visible to all (**Col. 8, lines 50-55**). Goldhaber does not explicitly teach the server selecting the highest bid and transferring the advertisement to the web site. However, it would have been obvious to the one ordinary skills in the art at the time of the invention was made to including a feature that selects the highest bidder and transmit advertisement to a web site in order to increase advertising revenue.

Claims 99 and 133: Goldhaber discloses a system and method for supplying advertisements, comprising:

b. receiving an indication of the request for content from a client including an advertising opportunity (**Col. 5, lines 6-16**, where "when selecting (requesting) ads for viewing, the consumer given a chance to express preference for certain kinds of ad content" reads on receiving an indication of the request for content from a client **Col. 10, lines 9-15**, which teaches customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers);

c. submitting bids based on matching the bidding parameters with the advertising opportunity (**Col. 4, lines 47-63**, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (specification);

d. including a monetary amount the advertiser is willing to pay if the advertisement is selected to display to the client (**Col. 2, lines 57-21**, which teaches mass media (web site) receive its revenue form advertisers;) and

e. selecting a bid and the corresponding advertisement by a bidding process (**Col. 5, lines 47-63**, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing



*preference and past consuming behavior (specification) and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction).*

Goldhaber teaches all elements as cited above including advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (*Col. 5, lines 47-63*) and database that stores demographic profiles of potential users and electronic trading house that contain buyers and sellers notation transaction (*abstract* ). Goldhaber does not explicitly teach maintaining (storing) a plurality of bidding parameters associated with an advertisement specifying at least web page characteristics. However, it would have been obvious to the one ordinary skill in the art to at the time of the invention was made to include a feature that stores a plurality of bidding parameters associated with the advertisements in order to identify the advertising media associated with particular advertisement.

**Examiner's Note:** The following limitations are added by numerous dependent claims with crossing dependencies. In order to eliminate redundant rejections of the same limitations, the claims including the same additional limitation have been grouped together.

Claims 100, 113, 123, 134, 147, and 157: Goldhaber discloses a system and method as in Claims 99 and 133 above and further discloses the monetary amount is included in the bid (*Col. 2, lines 57-21, which teaches mass media (web site) receive its revenue form advertisers*).

Claims 101, 114, 124, 135, 148, and 158: Goldhaber discloses a system and method as in Claims 99 and 133 above, and further discloses the specific event is the same for all submitted bids

(Goldhaber discloses the event is the selection of the advertisement by the client) (*Col. 2, lines 35-49, where "TV program" read on event, and "most likely to be purchase" reads on select*).

Claims 102, 103, 115, 116, 125, 126, 136, 137, 149, 150, 159, and 160: Goldhaber discloses a system and method as in Claims 99 and 133 above and further discloses the event is delivering (serving) the advertisement ((*Col. 2, lines 35-49, where "TV program" read on event, and "most likely to be purchase" reads on select*)).

Claims 104-108, 117-121, 127-131, 138-142, 151-155, and 161-165: Goldhaber discloses a system and method as in Claims 99 and 133 above, including linking ads to content being delivered to audience during TV show (*Col. 2, line s35-49*) and customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers(*Col. 10, lines 9-15*). Goldhaber does not explicitly teach the request for content by the browser is caused by a reference (link) in a web page. Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention was made to include browser feature in order to request advertisement via website.

### ***Response to Arguments***

9. Applicant's arguments filed 7 April 2011 have been fully considered but they are not persuasive.

Applicant argued in page 3 that Goldhaber fails to disclose a real-time bidding a selecting mechanism, whereby the winner bid is selected by the system in real-time that is at the time the web page is requested by a user, prior to the web page being transmitted to the user.

However, the Examiner respectfully disagrees with the applicant, Goldhaber teaches a real-time bidding a selecting mechanism, whereby the winner bid is selected by the system in real-time that is at the time the web page is requested by a user, prior to the web page being transmitted to the user. (**Col. 4, lines 52-54**, where “*bidding for a viewer attention*” reads on the auction mechanism) **and** provide for a real-time bidding (**Col. 4, lines 58-60**, where *bidding is automatic*” reads on a real time bidding) and selecting mechanism(**Col. 5, lines 47-63**, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (specification), **Col. 8, lines 212-30**, teaches online trading floor where buyer and sellers or software agents can actively negotiate transactions **Col. 20, lines 51-55**, which teaches agent-aided negotiation and bidding trusted agent transaction). Furthermore, claims 29 of Goldhaber shows that the claimed elements, for example, the step of performing at least one electronic financial transaction involving at least one of the said information provider computer, the said personal computer, and the said attention broker computer (see claim 21) is performed in real-time. Thus, it is obvious that Goldhaber’s online trading feature is a real-time bidding mechanism. Meanwhile the Examiner submits that no where in applicant’s specification disclose the “real-time” definition.

Applicant argued in page 3 that Goldhaber fails for instance, claim 99, including the following limitations: “receiving in the computer system an indication of the request for

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content... and in response to the request for content submitting in the computer system one or more bids..."

However, the Examiner respectfully disagrees Goldhaber teaches claim receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity (**Col. 5, lines 6-15**, where "selecting ads to for viewing" reads on receiving indication, and the customer would be given the chance to express a preference of certain kinds of, e.g., for a movie commercial on consumer might request a film clip ( indication) while another asks (indication) for a plot summer and **Col. 10, lines 9-15** customer request valuable information (reads on indication request for content) and teaches delivered to consumer in digital form via the consumer computers); and in response to request for content:

submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to " pay if the each submitted bid is selected and a specific event occurs (**Col. 1, lines 65-67**, teaches advertiser sponsor content by paying the mass media to deliver their advertisements with the content, **Col. 2, lines 57-21**, which teaches mass media (web site) receive its revenue form advertisers and **Col. 4, lines 49-63**, teaches advertisers actively compete by bidding for viewer attention, bids might be based in part estimates of the viewer's interest, where viewer's interest" reads on bidding parameters, and teaches viewers may elect to have advertiser bids for their attention ).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/SABA DAGNEW/  
Primary Examiner, Art Unit 3688